

The instant application was filed on September 19, 2001 and is wholly owned by Sony Corporation as evidenced by the recorded Assignment on Reel 012786 at Frame 0313. *Okada* issued on March 9, 2004 and is also wholly owned by Sony Corporation. MPEP §706.02(I)(1) states:

“[e]ffective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention ‘were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.’ This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues.”

Because *Okada* and the instant application are both owned by Sony Corporation and the instant application was filed after November 29, 1999, Applicant respectfully submits that *Okada* is not prior art.

The Office Action applied *Nakami* to remedy the deficiencies of *Okada*. However, Applicant submits that when taken individually *Nakami* fails to establish a *prima facie* case for either anticipation or obviousness with regards to claims 1-8. The mere fact that *Nakami* is used as a secondary reference is further evidence that this reference fails to disclose, teach, or suggest every element recited in claims 1-8.

In summary because *Okada* is not prior art and *Nakami* fails to disclose, teach, or suggest at least every element recited in the claims, a *prima facie* case for obviousness has not been established. Accordingly, Applicant respectfully requests that the rejection of claims 1-8 under 35 U.S.C. §103 be withdrawn.

Applicant respectfully submits that any subsequent Office Action should be a non-final Office Action. Applicant’s Amendment in Response to the Non-Final Office Action (Amendment) filed on September 30, 2004, does not change the scope of the claimed embodiment. In other words, the analysis of the claims with respect to their broadest reasonable interpretation was not affected by the claim amendment. *See* MPEP §904.

Conclusion

Based on at least the foregoing amendments and remarks, Applicant submits that claims 1-8 are allowable, and this application is in condition for allowance. Accordingly, Applicant requests a favorable examination and consideration of the instant application. In the event the instant application can be placed in even better form, Applicant requests that the undersigned attorney be contacted at the number listed below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-2213 from which the undersigned is authorized to draw.

Dated: September 22, 2005

Respectfully submitted,

By 
Ronald P. Kananen

Registration No.: 24,104

Shawn B. Cage

Registration No.: 51,522

Attorneys for Applicant

RADER, FISHMAN & GRAUER, PLLC

Lion Building

1233 20th Street, N.W., Suite 501

Washington, D.C. 20036

Tel: (202) 955-3750

Fax: (202) 955-3751

Customer No. 23353

DC208032